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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/629,464	07/31/2000	Hiroyuki Sayuda	046601-5056	5381

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EXAMINER

THOMPSON, JAMES A

ART UNIT PAPER NUMBER

2624

DATE MAILED: 11/12/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/629,464

Applicant(s)

SAYUDA, HIROYUKI

Examiner

James A Thompson

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--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 04 October 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
- ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☒ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: see attached.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attached.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:


Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: 1-7.

Claim(s) withdrawn from consideration: _____.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____.


THOMAS D.
LEE
PRIMARY EXAMINER

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Response to Amendment

1. The amendments to the claims will not be entered since the limitations added to the claims raise new issues that would require further consideration and a further search. Additionally, proposed new claims 8-20 will not be entered since a corresponding number of finally rejected claims have not been cancelled.

Response to Arguments

2. Applicant's arguments filed 4 October 2004 have been fully considered but they are not persuasive.

Regarding page 7, line 14 to page 9, line 5: Huttenlocher teaches the limitations of claim 1 not specifically addressed by Curry, as demonstrated on page 3, lines 8-14 of the final rejection, dated 3 June 2004. Despite Applicant's contention on page 8, lines 15-18 of Applicant's arguments, the motivation cited is indeed taught by Huttenlocher, as discussed on page 3, line 21 to page 4, line 2 of said final rejection. The motivation is with respect to the coupling information, as further demonstrated on page 3, lines 14-21 of said final rejection. Additionally, neither claim 1 nor any claims depending from claim 1 recites "an amount of collapsed coupling information due to the image superimposition." Claim 1 specifically recites "an embedding part that embeds the coupling information to be superimposed over at least part of the image element to form the document image ...".

On page 8, lines 18-23 of Applicant's arguments, Applicant states that "coupling information embedded in the image element can be adapted to have an embedded form in non-human readable format." However, this is not recited in the claims. The

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claims, as currently recited, have been disclosed in the prior art of record.

On page 8, line 23 to page 9, line 5, Applicant attempts to demonstrate a supposed advantage of the invention over the prior art. However, Applicant has not demonstrated the structural difference between the claimed invention and the prior art.

Regarding page 9, line 6 to page 10, line 9: In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "amount of image collapse due to image tokenization") are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Regarding page 10, lines 10-13: Claims 8-20 have not been entered and therefore will not be considered.